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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,882	09/23/2003	Safaa H. Hashim	021756-060120US	5268
51206 7590 10/20/2009 TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
PASS, NATALIE				
ART UNIT		PAPER NUMBER		
3686				
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10/20/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/669,882

Applicant(s)

HASHIM, SAFAA H.

Examiner

Natalie A. Pass

Art Unit

3686

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6, 8-12, 15-22, 24-28 and 31-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6, 8-12, 15-22, 24-28 and 31-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (P/TO/SB/08)
Paper No(s)/Mail Date 8 June 2009.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 19 June 2009. Claims 1, 7, 13-14, 23, 29-30 have been cancelled. Claims 2-5, 10, 16, 18-19, 21 have been amended. Claims 34-39 have been newly added. Grounds of rejection for claims 2-6, 8-12, 15-22, 24-28, 31-39 are set forth in detail below. The Information Disclosure Statement filed 8 June 2009 has been entered and considered.

Claim Objections

2. Applicant is advised that should claim 36 be found allowable, claim 39 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 101

3. The rejection of claims 2-12, 15-17 under 35 U.S.C. 101 is hereby withdrawn due to the amendment filed 19 June 2009.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2-6, 8-12, 15-17, 34-39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Claims 2 and 34 recite limitations that are new matter, and are therefore rejected.

The added material which is not supported by the original disclosure is as follows:

- "two participants," as disclosed in claim 2 at lines 13-14, 29, and in claim 34 at lines 9 and 18-19;
- "another of said tools and a second set of said data," as disclosed in claim 2 at lines 28-29;
- "a second set of said data," as disclosed in claim 34 at line 21.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

- a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 23 September 2003. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

(B) Claims 3-6, 8-12, 15-17, 35-39 incorporate the features of independent claims 2 and 34, through dependency, and are also rejected.

Applicant is required to cancel the new matter in the reply to this Office Action.

6. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 23 September 2003.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

NOTE: The following rejections assume that the subject matter added in the 19 June 2009 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration,

on the condition that Applicant properly traverses the new matter objections and rejections made in sections 3-5 above in the next communication sent in response to the present Office Action.

8. Claims 2-6, 8-12, 15-22, 24-28, 31-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Surbey et al. (WO 0225470 A1) for substantially the same reasons given in the previous Office Action (paper number 20090204). Further reasons appear hereinbelow.

(A) As per newly amended claim 2, Surbey teaches a method for facilitating communication in an insurance-underwriting process (Surbey; page 12, paragraphs 1-2), the method comprising:

providing a plurality of participants access to a web-based computer system for storing and organizing data related to the insurance-underwriting process (Surbey; page 8, paragraph 1 to page 9, paragraph 1, page 12, paragraphs 1-2);

storing and organizing data related to the insurance-underwriting process at the web-based system (Surbey; Figure 2, page 8, paragraph 1 to page 9, paragraph 1, page 12, paragraphs 1-2);

enabling, by the web-based computer system, collaboration among two participants of said participants from the plurality of participants via the Internet using the web-based system (Surbey; Figure 9, Item 9440, page 8, paragraph 1 to page 9, paragraph 1, page 12, paragraphs 1-2), the web-based system comprising a multi-level modular architecture, the multi-level modular architecture comprising a plurality of applications, each application of the plurality of applications comprising a plurality of modules, each module of the plurality of modules

comprising a plurality of tools, each tool of the plurality of tools comprising a plurality of views (Surbey; Figure 2, Figure 9, page 14, paragraph 3, page 15, paragraph 2, page 21, paragraph 1 to page 22, paragraph 3);

sharing, by the web-based computer system, the at least a portion of said data among the plurality of participants (Surbey; Figure 9, Item 9440, page 6, paragraphs 1-3, page 8, paragraph 2),

making a determination of, by the web-based computer system, based on a role associated with at least one said two participants at least one of said "folders" (reads on "tools") available to said at least one of said two participants and a first set of said data available to said at least one of said two participants (Surbey; Figure 9, Item 9314, page 8, paragraph 1 to page 9, paragraph 1, paragraph bridging pages 21-22); Examiner interprets Surbey's teachings of a "role-based permissions component" (Surbey; Figure 9, Item 9314, paragraph bridging pages 21-22) together with "[t]he software can enable the user to set "access rights" with respect to each collaborator. Those access rights can identify, specify, and/or determine whether the collaborator can "read only", "edit", and/or "delete" documents" (Surbey; page 8, paragraph 4) and Surbey's teachings of "the unique workspace that the software has rendered for each collaborator, the workspace containing only those folders to which that collaborator has been granted access" (Surbey; paragraph bridging pages 8-9) to teach a form of this limitation; and

restricting, by the web-based computer system, based on said determination, at least another of said "folders" (reads on "tools") and a second set of said data to said at least one of said two participants (Surbey; page 7, paragraph 4 to page 9, paragraph 1, page 12, paragraphs 1-

2, paragraph bridging pages 21-22); Examiner interprets Surbey's teachings of "a folder structure can be uniquely rendered to each user, thereby providing an always-current view of the folders and folder contents that the user has either created or been invited to access through the collaboration feature. One way of visualizing this is an electronic filing cabinet that can provide the user with instant access to any file they have created or are entitled to access. These files can be accessed anywhere/anytime through an Internet connection. The folder structure can have these features: The folder hierarchy can be determined by the user's role. For example, if the user is a broker [agent], the root folders can be associated with clients ... [...] ... the folder hierarchy can include standard sub-folders determined by the user's role ... [...] ..." (emphasis added) (Surbey; page 7, paragraph 4 to page 8, paragraph 1) together with Surbey's teachings of "the software can enable the user to set 'access rights' with respect to each collaborator. Those access rights can identify, specify, and/or determine whether the collaborator can 'read only', 'edit', and/or 'delete' documents" (Surbey; page 8, paragraphs 2-4) to teach a form of this limitation.

(B) As per newly amended claim 5, Surbey teaches a method as analyzed and discussed in claim 2 above, wherein the plurality of applications are adapted to employ a desktop visual metaphor for accessing the plurality of modules, said desktop visual metaphor including at least one selectable icon operable to activate at least one corresponding module (Surbey; Figure 5, Figure 9, page 4, paragraph 1, page 7, paragraph 4 to page 8, paragraph 3, paragraph bridging pages 11-12, page 12, paragraph 1, page 21, paragraph 1 to page 22, paragraph 2); Examiner submits that the applied Surbey reference teaches "software that incorporates an electronic folder structure ... [...] ... One way of visualizing this [metaphor] is an

electronic filing cabinet that can provide the user with instant access to any file they have created or are entitled to access. These files can be accessed anywhere/anytime through an Internet connection” (Surbey; page 7, paragraph 4) and Surbey teaches “[b]y clicking on the folder (“explorer”) bar [i.e. a “selectable icon”], the user can select the appropriate folder and folder level ... [...] ... to select collaborators” (Surbey; page 8, paragraph 3); Examiner interprets these teachings to demonstrate a form of employing a desktop visual metaphor for accessing the modules, said desktop visual metaphor including at least one selectable icon operable to activate at least one corresponding module.

(C) As per the amendments to claims 3-4, 10, 16, these appear to have been made merely to correct minor typographical or grammatical errors. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20090204, section 6, pages 5-8), and incorporated herein.

(D) Claims 6, 8-9, 11-12, 15, 17 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20090204, section 6, pages 5-8), and incorporated herein.

(E) Claim 18 differs from method claim 1, in that it is a system rather than a method for facilitating communication among participants in an insurance-underwriting process.

System claims 18-22, 24-28, 31-33 repeats the subject matter of claims 2-6, 8-12, 15-17, respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 2-6, 8-12, 15-17, have been shown to be fully disclosed by the teachings of Surbey in the above rejection of claims 2-6, 8-12, 15-17, it is readily apparent that the system disclosed by Surbey includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 2-6, 8-12, 15-17, and incorporated herein.

(F) Newly added claims 34-39 differ from method claims 2, 8, 9, 2, 5, 9, respectively by reciting a “computer readable storage medium having stored thereon instructions for ...” in the preamble. As per this limitation, Surbey clearly discloses his invention to be implemented on a “computer readable storage medium having stored thereon instructions for ...” (Surbey; page 7, paragraph 4, page 16, paragraph 1). The remainder of claims 34-39 repeat the limitations of claims 2, 8, 9, 2, 5, 9, and are therefore rejected for the same reasons given above for claims 2, 8, 9, 2, 5, 9.

Response to Arguments

9. Applicant’s arguments filed 19 June 2009 have been fully considered but they are not persuasive. Applicant’s arguments will be addressed hereinbelow in the order in which they appear in the response filed 19 June 2009.

(A) As per Applicant’s argument on pages 14-16 of the response filed 19 June 2009 that the applied Surbey reference fails to “disclose role-based permissions of data and/or tools,” Examiner submits that on pages 14-16 of the response filed 19 June 2009 Applicant admits that

the applied Surbey reference teaches “a role-based permissions component” and also admits that Surbey “describes restricting access to documents (i.e. data),” however Applicant argues that the applied reference fails to teach restricting access to “data and/or tools” based on “role.”

Examiner respectfully disagrees. Examiner interprets a folder to be a tool that enables a user to access data such as documents. Examiner submits that Surbey’s invention teaches not only “a role-based permissions component” (Surbey; Figure 9, Item 9314, paragraph bridging pages 21-22), as previously discussed, but also teaches “[o]ne way of visualizing this is an electronic filing cabinet that can provide the user with instant access to any [data] file they ... [...] ... are entitled to access. ... The folder [tool] structure can have these features: The folder [tool] hierarchy can be determined by the user’s role. For example, if the user [role] is a broker, the root folders [tools] can be associated with clients, ... If the user [role] is a client, then the root folder [tool] can be associated with one or more brokers and/or insurers ... The folder hierarchy can include standard sub-folders [tools] determined by the user’s role (emphasis added) (Surbey; page 7, paragraph 4 to page 8, paragraph 1). Further, in response to Applicant’s arguments regarding access to a “second set of data,” Examiner interprets Surbey’s teachings of “access to any [data] file they ... [...] ... are entitled to access” (Surbey; page 7, paragraph 4) to include a first set of data as well as a second set of data, and based on the broadest reasonable interpretation of this limitation, the rejection of claim 2 under 35 U.S.C. § 102(b) is proper and is thus maintained.

As per Applicant’s argument on pages 16-21 of the response filed 19 June 2009 that the applied Surbey reference fails to disclose limitations recited in claims 5 and 21, Examiner respectfully disagrees.

Firstly, as per Applicant's assertion in paragraph 1 on page 17 of the response filed 19 June 2009 that Official Notice was taken in the previous Office Action, Examiner respectfully notes that this was not the case. Examiner stated in the previous Office Action that:

"Examiner submits that computer desktop images are well-known in the art to be visual metaphors, that is, visual representations of something else, such as files or folders or software applications or software modules, etc., that are opened or initiated or viewed or accessed by inputting commands using input devices; and Examiner further submits that the applied Surbey reference teaches "software that incorporates an electronic folder structure ... [...] ... One way of visualizing this [metaphor] is an electronic filing cabinet that can provide the user with instant access to any file they have created or are entitled to access. These files can be accessed anywhere/anytime through an Internet connection" (Surbey; page 7, paragraph 4) and "[b]y clicking on the folder ("explorer") bar [i.e. a desktop icon], the user can select the appropriate folder and folder level ... [...] ... to select collaborators" (Surbey; page 8, paragraph 3), which Examiner interprets to be a form of adapted to employ a desktop visual metaphor for accessing the modules."

Examiner submits, however, that this is not taking "Official Notice," but merely stating something that is common knowledge in the art. Specifically, Examiner notes that the operating system known as Windows 3.0 was released in 1990, and accordingly, it is common knowledge or "well-known" that the opening computer screen/folder is known as the "desktop" within the "Windows™" GUI (graphical user interface) operating system." Examiner further submits that a "metaphor" is a figure of speech in which a term or phrase is applied to something to which it is not literally applicable in order to suggest a resemblance. Thus, Examiner notes that the visual metaphor of a "desktop," a place where files and folders (both paper and electronic) are

organized and arranged, and possibly stored, has been used by the Windows operating system since at least 1990, and therefore is well-known or common knowledge. Moreover, as disclosed in Applicant's specification, in order "[t]o improve user-friendliness, the ... [invention] ... leverages on the familiar desktop visual metaphor" (emphasis added) (Spec; paragraph [0049]), or in other words, the computer screen referred to as a "desktop," with its folders and icons, is a familiar visual metaphor for an actual desktop.

As per Applicant's arguments in pages 17-20 of the response filed 19 June 2009 that Surbey fails to disclose "said desktop visual metaphor including at least one selectable icon operable to activate at least one corresponding module," as recited in amended dependent claims 5 and 21, Examiner respectfully disagrees. Examiner submits that the applied Surbey reference teaches "software that incorporates an electronic folder structure ... [...] ... One way of visualizing this [metaphor] is an electronic filing cabinet that can provide the user with instant access to any file [reads on folder or module] they have created or are entitled to access ... " (emphasis added)(Surbey; page 7, paragraph 4) and Surbey teaches "[b]y clicking on the folder ("explorer") bar [i.e. a "selectable icon"], the user can select the appropriate folder and folder level ..." (Surbey; Figure 5, page 8, paragraph 3); Examiner interprets these teachings to demonstrate a form of employing a desktop visual metaphor for accessing files or folders or modules, said desktop visual metaphor including at least one selectable icon operable to activate at least one corresponding module.

As per Applicant's remarks on pages 20-21 of the response filed 19 June 2009 with response to an alleged "Official Notice" taking in a previous Office Action, these issues have been discussed earlier in this Office Action.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

11. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(571) 273-8300.**

For formal communications, please mark "EXPEDITED PROCEDURE".

For informal or draft communications, please label PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./

Examiner, Art Unit 3686

October 17, 2009

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686